

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Debora M. H. LITWILLER

GROUP: 2174

APPLICATION: 10/801,464

EXAMINER: B. Parker

FILED: March 16, 2004

CONFIRMATION: 3203

**FOR: METHOD AND SYSTEM FOR DISPLAYING ANNOTATED
INFORMATION ASSOCIATED WITH A SETTABLE VARIABLE
VALUE FEATURE**

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

REPLY BRIEF FOR APPELLANT

This Reply Brief is being submitted in response to the Examiner's Answer, dated August 4, 2010, in connection with the above-identified application.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Rejection of Claims 7-15 under 35 U.S.C. §101

The issue is whether claims 7-15 set forth a useful machine in accordance with 35 U.S.C. §101.

B. Rejection of Claims 1-20 under 35 U.S.C. §103

The issue is whether claims 1-20 are patentable over Frederiksen et al. (US Patent 6,859,287) in view of Marshall et al. (Published US Patent Application 2003/0070139) in accordance with 35 U.S.C. §103.

VII. ARGUMENTS

A. Rejection of Claims 7-15 under 35 U.S.C. §101

Claims 7-15 have been rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. This rejection under 35 U.S.C. §101 is respectfully traversed.

In formulating the rejection under 35 U.S.C. §101, the Examiner asserts:

The claimed invention *as a whole* must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result. [sic] However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement.

The Examiner further asserts:

Claim 7 discloses "a user interface for selecting and setting a variable value feature..." The user interface itself [sic] merely software rather than a machine, manufacture, process or composition of matter. As such, it fails to fall within a statutory category. Therefore, claim 7 is rejected because the claimed invention is directed to non-statutory subject matter.

With respect to the Examiner's first assertion, the Examiner has apparently invented a new requirement under 35 U.S.C. §101, namely the practical application requirement for a claim.

Moreover, the Examiner apparently has established this requirement as a requirement that trumps the utility requirement of 35 U.S.C. §101, which the Courts have clearly establish as a requirement of 35 U.S.C. §101, because the Examiner asserts that even if a claim satisfies the utility requirement of 35 U.S.C. §101, the claim may still not realize a “useful result” under “the practical application requirement.”

35 U.S.C. §101 requires that a patent (claims) be directed a new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. In other words, the claimed invention must have “utility.”

If a claimed invention has utility, by definition, the claimed invention is useful. In other words, the claimed invention, by definition, provides a useful result.

With respect to independent claim 7, independent claim 7 recites that a controller causes a display area to display an annotated message associated with a selected variable value feature along with a displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value associated with the selected variable value feature has an associated annotation message.

The displaying of an annotated message associated with a selected variable value feature provides the useful result of providing additional information to the user with respect to the selected value.

For example, the selected value may be 78% reduction but the annotated message can inform the user that this reduction percentage corresponds to reducing a legal size document to a letter size document.

This displaying of an annotated message is useful information because now the user has a concrete example associated with the displayed numeric value.

Moreover, the displaying of an annotated message is practical because a user may make the selection based upon the displayed annotated message as opposed to the displayed numeric value.

It is noted that the Examiner has not refuted this position.

In addition, independent claim 7 recites that the controller causes the display area to display no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message.

The displaying of no annotated message associated with a selected variable value feature provides the useful result of providing additional information to the user with respect to the selected value in that the selected value is not associated with a particular situation.

For example, the selected value may be 69% reduction, but the lack of an annotated message can inform the user that this reduction percentage does not correspond to reducing a legal size document to a letter size document.

This displaying of no annotated message is useful information because the user knows that the selected value is not associated with a particular situation.

Moreover, the displaying of no annotated message is practical because a user may make the selection based upon the lack of a displayed annotated message as opposed to the displayed numeric value.

It is noted that the Examiner has not refuted this position.

Furthermore, the claimed invention of independent claim 7 provides a machine that manages the displaying of information. The management of the displaying of information and programming of a machine is a specific practical utility.

It is noted that the Examiner has not refuted this position.

Therefore, independent claim 7 sets forth a specific and substantial utility.

In the Examiner's second assertion, the Examiner claims that the claimed user interface is merely software, notwithstanding the specific claimed elements of the claim. In other words, the Examiner apparently is asserting that claims 7-15 fail to set forth the necessary physical articles to constitute a machine. This assertion is unsupportable in view of the actual and expressed language of claims 7-15.

As set forth above, independent claim 7 claims a user interface that comprises a display area, a user activatable area, a memory, and a controller.

Independent claim 7 recites a display area to display a first numeric value associated with a user selected variable value feature. Notwithstanding, the Examiner asserts that the claimed display area is merely software.

As is readily appreciated by those skilled in the art, software is a set of intangible instructions that instructs a physical hardware device to perform certain operations. Software, in of itself, cannot perform functions.

Contrary to the Examiner's position, software, alone, cannot display a first numeric value associated with a user selected variable value feature. A physical device is needed to display a first numeric value associated with a user selected variable value feature.

It is noted that the Examiner has not refuted this position.

In addition, independent claim 7 recites a user activatable area to change the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount so as to display a second numeric value associated with the selected variable value feature. Notwithstanding, the Examiner asserts that the claimed user activatable area is merely software.

Contrary to the Examiner's position, software, alone, cannot provide a user activatable area so that the displayed first numeric value associated with the selected variable value feature can be changed by a predetermined numeric amount so as to display a second numeric value associated with the selected variable value feature.

It is noted that the Examiner has not refuted this position.

Moreover, independent claim 7 recites a memory for storing a number of annotated messages, each annotated message being associated a numeric value of the user selected variable value feature, the annotated message expressing information equivalent to the associated numeric value of the user selected variable value feature in a non-numeric form. Notwithstanding, the Examiner asserts that the claimed memory is merely software.

Contrary to the Examiner's position, software, alone, cannot store a number of annotated messages. A physical device is needed to store a number of annotated messages.

It is noted that the Examiner has not refuted this position.

Lastly, independent claim 7 recites that a controller causes the display area to display the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value associated with the selected variable value feature has an associated annotation message. Notwithstanding, the Examiner asserts that the claimed controller is merely software.

Contrary to the Examiner's position, software, alone, cannot cause a display area to display an annotated message. A physical device is required cause a display area to display an annotated message.

It is noted that the Examiner has not refuted this position.

Therefore, claims 7-15 explicitly recite a machine that includes physical devices which perform the claimed functions, not merely software, because software cannot, in of itself, perform such functions.

Accordingly, in view of all the reasons set forth above and set forth in the previously filed Appeal Brief, the Honorable Board is respectfully requested to reconsider and overturn the present rejection under 35 U.S.C. §101.

B. Rejection of Claims 1-20 under 35 U.S.C. §103

Claims 1-20 have been rejected under 35 U.S.C. §103 as being unpatentable over Frederiksen et al. (US Patent 6,859,287) in view of Marshall et al. (Published US Patent Application 2003/0070139). This rejection under 35 U.S.C. §103 is respectfully traversed.

Independent Claim 1

As set forth above, independent claim 1 sets forth a method of setting a variable value feature, having a plurality of values associated therewith wherein the plurality of values include a default value and a plurality of non-default values, on a user interface, the user interface having user activatable areas enabling a selection and changing of the variable value feature. The method displays, on the user interface, a first numeric value associated with a user selected variable value feature; changes the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount so as to display a second numeric value associated with the selected variable value feature by a user engaging a user activatable area of the user interface associated with the selected variable value feature; and determines if an annotated message is associated with the displayed second numeric value associated with the selected variable value feature, the annotated message expressing information equivalent to the displayed second numeric value in a non-numeric form.

The method displays the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second value associated with the selected variable value feature has an associated annotation message and displays no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message.

In formulating the rejection, the Examiner alleges that Frederiksen et al. illustrates, by reference item 64 of Figure 1, that the copier displays, on the user interface, a first numeric value associated with a user selected variable value feature.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected document size.

Therefore, contrary to the Examiner's assertion, Frederiksen et al. fails to disclose or suggest that reference item 64 of Figure 1 is a first numeric value associated with a user selected variable value feature, as set forth by independent claim 1.

In rebuttal, the Examiner asserts that Frederiksen et al. teaches that reference 54 of Figure 1 displays a numeric value associated with a user selected variable value feature.

Is the Examiner relying upon reference item 64 of Figure 1 or reference item 54 of Figure 1 to show the displaying of a numeric value associated with a user selected variable value feature?

The Applicant respectfully requests clarification.

Moreover, the Examiner alleges, in formulating the rejection, that Frederiksen et al. discloses, at column 3, lines 55-62, that the copier determines if an annotated message is associated with the displayed second numeric value associated with the selected variable value feature.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected original document size. Frederiksen et al. teaches, at column 4, lines 11-21, that the original document size and the copy size can be selected by activating one of the buttons (78, 80, 82, 84, 86, 88, 90, 92, or 96) illustrated in Figure 3.

More specifically, Frederiksen et al. teaches that the annotation displayed in areas 64 of Figure 1 are controlled by the activation of the buttons illustrated in Figure 3.

As set forth by independent claim 1, the second numeric value associated with the selected variable value feature is displayed in response to a user engaging a user activatable area of the user interface associated with the selected variable value feature. The Examiner alleges that this limitation is associated with the activation of buttons 54 and 56 of Figure 1 of Frederiksen et al.

Moreover, as set forth by independent claim 1, it is determined if an annotated message is associated with **the displayed second numeric value** associated with the selected variable value feature wherein this displayed second numeric value is a result of engaging a user activatable area of the user interface.

In contrast, Frederiksen et al. fails to teach or suggest, at column 3, lines 55-62, that reference item 64 of Figure 1 is an annotated message associated with the displayed second numeric value generated by the engaging of buttons 54 and 56 of Figure 1 because Frederiksen et al. specifically teaches that the annotated message associated with reference item 64 of Figure 1 is caused by the engaging one of the various buttons illustrated in Figure 3 of Frederiksen et al.

As illustrated and taught by Frederiksen et al., reference item 64 of Figure 1 does not change in response to activation buttons 54 and 56.

Therefore, Frederiksen et al. fails to teach or suggest that reference item 64 of Figure 1 is an annotated message associated with the displayed second numeric value associated with the selected variable value feature (magnification, the variable value feature associated with buttons 54 and 56).

In rebuttal, the Examiner asserts that Figure 1 displays annotation with respect to a letter size and a ledger size. Although this is a correct description of Figure 1, Figure 1 also does not illustrate any numeric value in area 52 when annotation is being displayed.

Therefore, at best, Figure 1 clearly illustrates that when annotation is being displayed, no numeric values are being displayed.

The Examiner's assertion that a numeric value is being displayed with the annotation is merely conjecture as Figure 1 does not support such a position.

It is noted that Marshall et al. also fails to disclose or suggest displaying the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second value associated with the selected variable value feature has an associated annotation message.

Lastly, the Examiner recognizes that Frederiksen et al. fails to disclose that the copier displays no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

To meet this deficiency, the Examiner alleges that Marshall et al., from some extrapolation of the illustration of Figure 3, discloses the displaying of no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

In contrast, Marshall et al. illustrates, in Figure 3, an example of an annotated document. Based upon this single illustration, the Examiner contrives a process of handling annotations on a document. The Examiner fails to provide any factual evidence from Marshall et al. to support the Examiner's allegations.

Initially, the teachings of Marshall et al., which are directed to providing emphasis to certain freeform annotations found on a document lack any nexus to the teachings of Frederiksen et al., which are directed to a user interface, let alone any nexus to the claimed invention, which recites a user interface that does not display an annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

More specifically, the teachings of Marshall et al. are not relevant or analogous to the teaching of Frederiksen et al. or the claimed invention.

Thus, contrary to the Examiner's assertion, Marshall et al. fails to disclose or suggest displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

In summary, Frederiksen et al. and Marshall et al., singly or in combination, fail to disclose, suggest, or render obvious to one of ordinary skill in the art, as set forth by independent claim 1:

(1) determining if an annotated message is associated with the displayed second numeric value associated with the selected variable value feature, the annotated message expressing information equivalent to the displayed second numeric value in a non-numeric form;

(2) displaying the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second value associated with the selected variable value feature has an associated annotation message; and/or

(3) displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message.

Independent Claim 7

As set forth above, independent claim 7 sets forth a user interface for selecting and setting a variable value feature, having a plurality of values associated therewith wherein the plurality of values include a default value and a plurality of non-default values. The user interface includes a display area to display a first numeric value associated with a user selected variable value feature; a user activatable area to change the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount so as to display a second numeric value associated with the selected variable value feature; a memory for storing a number of annotated messages, each annotated message being associated a numeric value of the user selected variable value feature, the annotated message expressing information equivalent to the associated numeric value of the user selected variable value feature in a non-numeric form; and a controller to determine if a stored annotated message is associated with the displayed second numeric value associated with the selected variable value feature.

The controller causes the display area to display the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value associated with the selected variable value feature has an associated annotation message. The controller causes the display area to display no annotated message associated when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message.

In formulating the rejection, the Examiner alleges that Frederiksen et al. illustrates, by reference item 64 of Figure 1, that the copier displays, on the user interface, a first numeric value associated with a user selected variable value feature.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected document size.

Therefore, contrary to the Examiner's assertion, Frederiksen et al. fails to disclose or suggest that reference item 64 of Figure 1 is a first numeric value associated with a user selected variable value feature, as set forth by independent claim 1.

In rebuttal, the Examiner asserts that Frederiksen et al. teaches that reference 54 of Figure 1 displays a numeric value associated with a user selected variable value feature.

Is the Examiner relying upon reference item 64 of Figure 1 or reference item 54 of Figure 1 to show the displaying of a numeric value associated with a user selected variable value feature?

The Applicant respectfully requests clarification.

Moreover, the Examiner alleges, in formulating the rejection, that Frederiksen et al. discloses, at column 3, lines 55-62, that the copier determines if an annotated message is associated with the displayed second numeric value associated with the selected variable value feature.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected original document size. Frederiksen et al. teaches, at column 4, lines 11-21, that the original document size and the copy size can be selected by activating one of the buttons (78, 80, 82, 84, 86, 88, 90, 92, or 96) illustrated in Figure 3.

More specifically, Frederiksen et al. teaches that the annotation displayed in areas 64 of Figure 1 are controlled by the activation of the buttons illustrated in Figure 3.

As set forth by independent claim 7, the second numeric value associated with the selected variable value feature is displayed in response to a user engaging a user activatable area of the user interface associated with the selected variable value feature. The Examiner alleges that this limitation is associated with the activation of buttons 54 and 56 of Figure 1 of Frederiksen et al.

Moreover, as set forth by independent claim 7, it is determined if an annotated message is associated with **the displayed second numeric value** associated with the selected variable value feature wherein this displayed second numeric value is a result of engaging a user activatable area of the user interface.

In contrast, Frederiksen et al. fails to teach or suggest, at column 3, lines 55-62, that reference item 64 of Figure 1 is an annotated message associated with the displayed second numeric value generated by the engaging of buttons 54 and 56 of Figure 1 because Frederiksen et al. specifically teaches that the annotated message associated with reference item 64 of Figure 1 is caused by the engaging one of the various buttons illustrated in Figure 3 of Frederiksen et al.

As illustrated and taught by Frederiksen et al., reference item 64 of Figure 1 does not change in response to activation buttons 54 and 56.

Therefore, Frederiksen et al. fails to teach or suggest that reference item 64 of Figure 1 is an annotated message associated with the displayed second numeric value associated with the selected variable value feature (magnification, the variable value feature associated with buttons 54 and 56).

In rebuttal, the Examiner asserts that Figure 1 displays annotation with respect to a letter size and a ledger size. Although this is a correct description of Figure 1, Figure 1 also does not illustrate any numeric value in area 52 when annotation is being displayed.

Therefore, at best, Figure 1 clearly illustrates that when annotation is being displayed, no numeric values are being displayed.

The Examiner's assertion that a numeric value is being displayed with the annotation is merely conjecture as Figure 1 does not support such a position.

It is noted that Marshall et al. also fails to disclose or suggest displaying the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second value associated with the selected variable value feature has an associated annotation message.

Lastly, the Examiner recognizes that Frederiksen et al. fails to disclose that the copier displays no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

To meet this deficiency, the Examiner alleges that Marshall et al., from some extrapolation of the illustration of Figure 3, discloses the displaying of no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

In contrast, Marshall et al. illustrates, in Figure 3, an example of an annotated document. Based upon this single illustration, the Examiner contrives a process of handling annotations on a document. The Examiner fails to provide any factual evidence from Marshall et al. to support the Examiner's allegations.

Initially, the teachings of Marshall et al., which are directed to providing emphasis to certain freeform annotations found on a document lack any nexus to the teachings of Frederiksen et al., which are directed to a user interface, let alone any nexus to the claimed invention, which recites a user interface that does not display an annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

More specifically, the teachings of Marshall et al. are not relevant or analogous to the teaching of Frederiksen et al. or the claimed invention.

Thus, contrary to the Examiner's assertion, Marshall et al. fails to disclose or suggest displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

In summary, Frederiksen et al. and Marshall et al., singly or in combination, fail to disclose, suggest, or render obvious to one of ordinary skill in the art, as set forth by independent claim 7:

- (1) determining if an annotated message is associated with the displayed second numeric value associated with the selected variable value feature, the annotated message expressing information equivalent to the displayed second numeric value in a non-numeric form;

(2) displaying the annotated message associated with the selected variable value feature along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second value associated with the selected variable value feature has an associated annotation message; and/or

(3) displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message.

Independent Claim 16

As set forth above, independent claim 16 sets forth a method of setting a variable value feature on a control panel, the variable value feature having a plurality of values associated therewith, wherein the plurality of values include a default value, at least one industry accepted standard value, and a plurality of non-default values, the control panel having user activatable areas enabling a selection and changing of the variable value feature. The method displays, on a display device, a first numeric value associated with a user selected variable value feature; changes the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount so as to display a second numeric value associated with the selected variable value feature by a user engaging one of the user activatable areas of the control panel associated with the selected variable value feature; determines if the displayed second numeric value is an industry accepted standard value associated with the displayed second numeric value; displays an annotated message corresponding to the industry accepted standard value along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value is an industry accepted standard value associated with the selected variable value feature, the annotated message expressing the industry accepted standard value associated with the displayed second numeric value in a non-numeric form; and displays no annotated message when it is determined that the displayed second numeric value is not an industry accepted standard value associated with the selected variable value feature.

In formulating the rejection, the Examiner alleges that Frederiksen et al. illustrates, by reference item 64 of Figure 1, that the copier displays, on the user interface, a first numeric value associated with a user selected variable value feature.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected document size.

Therefore, contrary to the Examiner's assertion, Frederiksen et al. fails to disclose or suggest that reference item 64 of Figure 1 is a first numeric value associated with a user selected variable value feature, as set forth by independent claim 1.

In rebuttal, the Examiner asserts that Frederiksen et al. teaches that reference 54 of Figure 1 displays a numeric value associated with a user selected variable value feature.

Is the Examiner relying upon reference item 64 of Figure 1 or reference item 54 of Figure 1 to show the displaying of a numeric value associated with a user selected variable value feature?

The Applicant respectfully requests clarification.

Moreover, the Examiner alleges, in formulating the rejection, that Frederiksen et al. discloses, at column 3, lines 55-62, that the copier determines if the displayed second numeric value is an industry accepted standard value associated with the displayed second numeric value.

In contrast, Frederiksen et al. teaches, at column 3, lines 55-62, that reference item 64 of Figure 1 is a graphical document image corresponding to a selected original document size. Frederiksen et al. teaches, at column 4, lines 11-21, that the original document size and the copy size can be selected by activating one of the buttons (78, 80, 82, 84, 86, 88, 90, 92, or 96) illustrated in Figure 3.

More specifically, Frederiksen et al. teaches that the annotation displayed in areas 64 of Figure 1 are controlled by the activation of the buttons illustrated in Figure 3.

As set forth by independent claim 16, the second numeric value associated with the selected variable value feature is displayed in response to a user engaging a user activatable area of the user interface associated with the selected variable value feature. The Examiner alleges that this limitation is associated with the activation of buttons 54 and 56 of Figure 1 of Frederiksen et al.

Moreover, as set forth by independent claim 16, it is determined if an industry accepted standard value is associated with **the displayed second numeric value** associated with the selected variable value feature wherein this displayed second numeric value is a result of engaging a user activatable area of the user interface.

In contrast, Frederiksen et al. fails to teach or suggest, at column 3, lines 55-62, that reference item 64 of Figure 1 is an annotated message associated with the displayed second numeric value generated by the engaging of buttons 54 and 56 of Figure 1 because Frederiksen et al. specifically teaches that the annotated message associated with reference item 64 of Figure 1 is caused by the engaging one of the various buttons illustrated in Figure 3 of Frederiksen et al.

As illustrated and taught by Frederiksen et al., reference item 64 of Figure 1 does not change in response to activation buttons 54 and 56.

Therefore, Frederiksen et al. fails to teach or suggest that reference item 64 of Figure 1 is an industry accepted standard value associated with the displayed second numeric value associated with the selected variable value feature (magnification, the variable value feature associated with buttons 54 and 56).

In rebuttal, the Examiner asserts that Figure 1 displays annotation with respect to a letter size and a ledger size. Although this is a correct description of Figure 1, Figure 1 also does not illustrate any numeric value in area 52 when annotation is being displayed.

Therefore, at best, Figure 1 clearly illustrates that when annotation is being displayed, no numeric values are being displayed.

The Examiner's assertion that a numeric value is being displayed with the annotation is merely conjecture as Figure 1 does not support such a position.

It is noted that Marshall et al. also fails to disclose or suggest displaying an annotated message corresponding to the industry accepted standard value along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value is an industry accepted standard value associated with the selected variable value feature, the annotated message expressing the industry accepted standard value associated with the displayed second numeric value in a non-numeric form.

Lastly, the Examiner recognizes that Frederiksen et al. fails to disclose that the copier displays no annotated message when it is determined that the displayed second numeric value is not an industry accepted standard value associated with the selected variable value feature.

To meet this deficiency, the Examiner alleges that Marshall et al., from some extrapolation of the illustration of Figure 3, discloses the displaying of no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

In contrast, Marshall et al. illustrates, in Figure 3, an example of an annotated document. Based upon this single illustration, the Examiner contrives a process of handling annotations on a document. The Examiner fails to provide any factual evidence from Marshall et al. to support the Examiner's allegations.

Initially, the teachings of Marshall et al., which are directed to providing emphasis to certain freeform annotations found on a document lack any nexus to the teachings of Frederiksen et al., which are directed to a user interface, let alone any nexus to the claimed invention, which recites a user interface that does not display an annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message wherein the annotated message expresses information equivalent to the displayed second numeric value in a non-numeric form.

More specifically, the teachings of Marshall et al. are not relevant or analogous to the teaching of Frederiksen et al. or the claimed invention.

Thus, contrary to the Examiner's assertion, Marshall et al. fails to disclose or suggest displaying no annotated message when it is determined that the displayed second numeric value is not an industry accepted standard value associated with the selected variable value feature.

In summary, Frederiksen et al. and Marshall et al., singly or in combination, fail to disclose, suggest, or render obvious to one of ordinary skill in the art, as set forth by independent claim 16:

(1) determining if the displayed second numeric value is an industry accepted standard value associated with the displayed second numeric value;

(2) displaying an annotated message corresponding to the industry accepted standard value along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value is an industry accepted standard value associated with the selected variable value feature, the annotated message expressing the industry accepted standard value associated with the displayed second numeric value in a non-numeric form; and/or

(3) displaying no annotated message when it is determined that the displayed second numeric value is not an industry accepted standard value associated with the selected variable value feature.

Accordingly, for all the reasons set forth above and set forth in the previous filed Appeal Brief, the Honorable Board is respectfully requested to reconsider and overturn the present rejection under 35 U.S.C. §103.

Conclusion

Accordingly, for all the reasons set forth above and set forth in the previous filed Appeal Brief, the Honorable Board is respectfully requested to reverse all the outstanding rejections. Also, an early indication of allowability is earnestly solicited.

Respectfully submitted,



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